

PATENT

Application No. 09/247,281
Attorney Docket No.: 99-006

REMARKS

Claims 1 – 60 were pending.

Claims 13 – 30 were allowed.

Claims 41 – 43, 52 – 53 and 55 – 56 would be allowable if rewritten.

Claims 1 – 12, 31 – 37, 39 – 40, 44 – 51, 54 and 57 – 60 have been canceled.

Claims 13 – 30, 38, 41 – 43, 52 – 53 and 55 – 56 remain pending after entry of the present amendments.

1. Information Disclosure Statement

Copies of the requested references are attached for the Examiner's consideration. Applicants respectfully request that the Examiner indicate his consideration of the attached references.

2. Section 112 Rejections

Claim 36 was rejected as being indefinite.

Claim 36 has been canceled to be pursued in a continuing application, solely to expedite allowance of the present application.

3. Section 101 Rejections

Claim 38 was rejected as being non-statutory for violating public policy. Applicants respectfully traverse the Examiner's Section 101 rejection. First, Section 101 does not prohibit misleading inventions. Second, the claimed embodiment is not misleading.

A misleading invention is not improper.

It is improper to reject a claim because the invention is "misleading". The Federal Circuit has recently overturned older case law where patents were held invalid because they deceived consumers.

In Juicy Whip Inc. v. Orange Bang Inc., 51 USPQ2d 1700, 1703 (Fed. Cir. 1999), the Federal Circuit held that there is:

"no basis in section 101 to hold that inventions can be ruled unpatentable for lack of utility simply because they have the capacity to fool some members of the public."

The Federal Circuit also stated:

"The requirement of "utility" in patent law is not a directive to the Patent and Trademark Office or the courts to serve as arbiters of deceptive trade practices. Other agencies, such as the Federal Trade Commission and the Food and Drug Administration, are assigned the task of protecting consumers from fraud and deception in the sale of food products."

Accordingly, the Section 101 rejection is improper and should be withdrawn in light of the prevailing case law.

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The Examiner has misinterpreted claim 38. In the embodiment of claim 38, the step of: *charging the customer the second price for the at least one item* comprises:
charging the total price to a credit card account

In other words, the step of *charging the total price* is part of *charging the customer the second price*. However, since the second price is less than the total price, the customer cannot merely be charged the total price – in several embodiments he also receives a credit. For example, see page 18, lines 11 – 16 of the present application:

“Charging a reduced price may comprise charging the conventional (i.e. unreduced) price followed by crediting the customer a discount amount. For example, if the items are normally sold for \$25 (as determined by prices specified by the item database 340), then \$25 is charged to a credit card account of the customer, and a discount amount (perhaps \$25 as well) is credited to the credit card account.” (emphasis added)

Thus, the embodiment of claim 38 does not “mislead” the customer in the manner proposed by the Examiner, and the Section 101 rejection should be withdrawn.

4. Section 102 Rejections

Claims 1 – 4, 7, 12, 31, 32, 39, 44 – 50, 54, 57, 59 and 60 stand rejected as anticipated by U.S. Patent No. 6,076,069 to Laor.

The rejected claims have been canceled to be pursued in a continuing application, solely to expedite allowance of the present application.

5. Section 103(a) Rejections

Claims 5, 6, 8 – 11, 33 – 37, 40, 51 and 58 are rejected as being unpatentable over Laor.

The rejected claims have been canceled to be pursued in a continuing application, solely to expedite allowance of the present application.

6. Amendments to Allowable Claims

The allowable claims, except claim 42, have been amended to eliminate dependencies on rejected base claims. Claim 42 was not amended because it depends from claim 41, which has been amended.

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For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.

Petition for Extension of Time to Respond

Applicants believe no fee is due. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,



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Date

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Application No. 09/247,281
Attorney Docket No.: 99-006S P E C I F I C A T I O N A M E N D M E N T S
M A R K E D U P F O R M

Please REPLACE the paragraph on page 1, ending on page 2, between the Title of the invention and the Field of the Invention with the following:

The present application is a continuation-in-part application of co-pending U.S. Patent Application No. 09/219,267 entitled "METHOD AND APPARATUS FOR FACILITATING ELECTRONIC COMMERCE THROUGH PROVIDING CROSS-BENEFITS DURING A TRANSACTION" to Jay S. Walker and Daniel E. Tedesco filed on December 23, 1998, which is a continuation-in-part application of co-pending U.S. patent application Serial No. 08/943,483 entitled "SYSTEM AND METHOD FOR FACILITATING ACCEPTANCE OF CONDITIONAL PURCHASE OFFERS (CPOs)" to Andrew S. Van Luchene, Daniel E. Tedesco, James A. Jorasch, Jay S. Walker and Thomas M. Sparico filed on October 3, 1997, which is a continuation-in-part of co-pending U.S. patent application Serial No. 08/923,683 entitled "CONDITIONAL PURCHASE OFFER (CPO) MANAGEMENT SYSTEM FOR PACKAGES" to Andrew S. Van Luchene, Daniel E. Tedesco, James A. Jorasch, Jay S. Walker and T. Scott Case filed September 4, 1997, which is a continuation-in-part of U.S. patent application Serial No. 08/889,319 entitled "CONDITIONAL PURCHASE OFFER MANAGEMENT SYSTEM" to Bruce Schneier, James A. Jorasch, Jay S. Walker and T. Scott Case filed July 8, 1997, which is a continuation-in-part of U.S. Patent No. 5,794,207 entitled "METHOD AND APPARATUS FOR A CRYPTOGRAPHICALLY ASSISTED COMMERCIAL NETWORK SYSTEM DESIGNED TO FACILITATE BUYER-DRIVEN CONDITIONAL PURCHASE OFFERS" issued to Bruce Schneier, James A. Jorasch and Jay S. Walker on August 11, 1998; and a continuation-in-part of co-pending U.S. patent application Serial No. 09/100,684 entitled "BILLING STATEMENT CUSTOMER ACQUISITION SYSTEM" to Daniel E. Tedesco, James A. Jorasch and Jay S. Walker filed on June 19, 1998, which is a continuation-in-part of co-pending U.S. patent application Serial No. 08/982,149 entitled "METHOD AND APPARATUS FOR PRINTING A BILLING STATEMENT TO PROVIDE SUPPLEMENTARY PRODUCT SALES" to Jay S. Walker, Daniel E. Tedesco, Andrew S. Van Luchene and Dean P. Alderucci filed on December 1, 1997[,] and issued on March 6, 2001 as U.S. Patent No. 6,196,458 B1; and a continuation-in-part of co-pending U.S.

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patent application Serial No. 08/994,426 entitled :METHOD AND APPARATUS FOR PROVIDING SUPPLEMENTARY PRODUCT SALES TO A CUSTOMER AT A CUSTOMER TERMINAL" to Jay S. Walker, Andrew S. Van Luchene and Daniel E. Tedesco filed on December 19, 1997, which is a continuation-in-part of co-pending U.S. patent application Serial No. 08/920,116 entitled "METHOD AND SYSTEM FOR PROCESSING SUPPLEMENTARY PRODUCT SALES AT A POINT-OF-SALE TERMINAL" to Jay S. Walker, James A. Jorasch and Andrew S. Van Luchene filed on August 26, 1997[,] and issued on September 12, 2000 as U.S. Patent No. 6,119,099; which is a continuation-in-part of co-pending U.S. patent application Serial No. 08/822,709 entitled "SYSTEM AND METHOD FOR PERFORMING LOTTERY TICKET TRANSACTIONS UTILIZING POINT-OF-SALE TERMINALS" to Jay S. Walker, James A. Jorasch and Sanjay K. Jindal filed on March 21, 1997[,] and issued on July 31, 2001 as U.S. Patent No. 6,267,670 B1; each of the foregoing applications incorporated herein by reference.

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M A R K E D U P F O R M

Please CANCEL Claims 1 – 12, 31 – 37, 39 – 40, 44 – 51, 54 and 57 – 60.

Please AMEND the claims as follows

41. (AMENDED) [The method of claim 31, further] A method comprising:
transmitting an indication of at least one item that a customer is to purchase, the at least
one item having an associated total price;
receiving, in response to the transmitted indication of the at least one item, an indication
of an offer for a subsidy from a vendor;
providing to the customer, in response to the received indication of the offer, the offer for
the subsidy, the step of providing the offer being performed before the item is purchased;
receiving from the customer an acceptance of the offer;
transmitting an indication of the acceptance of the offer;
charging the customer a second price for the at least one item, the second price being less
than the total price; and
receiving an amount of funds from the vendor.

43. (AMENDED) [The method of claim 31, further] A method comprising:
transmitting an indication of at least one item that a customer is to purchase, the at least
one item having an associated total price;
receiving, in response to the transmitted indication of the at least one item, an indication
of an offer for a subsidy from a vendor;
providing to the customer, in response to the received indication of the offer, the offer for
the subsidy, the step of providing the offer being performed before the item is purchased;
receiving from the customer an acceptance of the offer;
transmitting an indication of the acceptance of the offer;
charging the customer a second price for the at least one item, the second price being less
than the total price; and
receiving an amount of funds from a party other than the customer.

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52. (AMENDED) [The method of claim 51, in which the step of providing to the customer the offers for the subsidies comprises] A method comprising:

transmitting an indication of at least one item that a customer is to purchase, the at least one item having an associated total price;

receiving, in response to the transmitted indication of the at least one item, an indication of a plurality of offers for subsidies from a vendor;

sequentially providing to the customer, in response to the received indication of the offers, the offers for the subsidies,

the step of sequentially providing the offers being performed before the item is purchased,

the step of sequentially providing the offers including

providing a first offer of the plurality of offers to the customer,;

receiving from the customer a rejection of the first offer,; and

providing a second offer of the plurality of offers to the customer after receiving the rejection;

receiving from the customer an acceptance of the offer;

transmitting an indication of the acceptance of the offer; and

charging the customer a second price for the at least one item, the second price being less than the total price.

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53. (AMENDED) [The method of claim 51, further comprising] A method comprising:
transmitting an indication of at least one item that a customer is to purchase, the at least
one item having an associated total price;
receiving, in response to the transmitted indication of the at least one item, an indication
of a plurality of offers for subsidies from a vendor;
ascertaining a rank of each offer of the plurality of offers;
sequentially providing to the customer, in response to the received indication of the
offers, the offers for the subsidies
[and in which the step of providing to the customer the offers for the subsidies comprises:
providing the offers for the subsidies] in a sequence defined by the rank of each offer; [.]
the step of sequentially providing the offers being performed before the item is
purchased;
receiving from the customer an acceptance of the offer;
transmitting an indication of the acceptance of the offer; and
charging the customer a second price for the at least one item, the second price being less
than the total price.

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55. (AMENDED) [The method of claim 54, in which the step of selecting at least one offer comprises] A method comprising:

transmitting an indication of at least one item that a customer is to purchase, the at least one item having an associated total price;

receiving, in response to the transmitted indication of the at least one item, an indication of a plurality of offers for a subsidies from a vendor;

providing to the customer, in response to the received indication of the offer, the offer for the subsidy, the step of providing the offer being performed before the item is purchased, the step of providing including

selecting [the] at least one offer based on a historical acceptance rate of each offer of the plurality of offers, and

providing to the customer the selected at least one offer;

receiving from the customer an acceptance of the offer;

transmitting an indication of the acceptance of the offer; and

charging the customer a second price for the at least one item, the second price being less than the total price.

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56. (AMENDED) [The method of claim 54, in which the step of selecting at least one offer comprises] A method comprising:

transmitting an indication of at least one item that a customer is to purchase, the at least one item having an associated total price;

receiving, in response to the transmitted indication of the at least one item, an indication of a plurality of offers for a subsidies from a vendor;

providing to the customer, in response to the received indication of the offer, the offer for the subsidy, the step of providing the offer being performed before the item is purchased, the step of providing including

selecting [the] at least one offer based on a profit of each offer of the plurality of offers, and

providing to the customer the selected at least one offer;

receiving from the customer an acceptance of the offer;

transmitting an indication of the acceptance of the offer; and

charging the customer a second price for the at least one item, the second price being less than the total price.